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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/244,043	02/04/1999	HIRONORI KANNO	826.1535/JDH	3301

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EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 11/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/244,043

Applicant(s)

KANNO ET AL.

Examiner

Stephen S. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-14, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This office action is responsive to Amendment D, filed 10/6/03 and RCE filed on 11/5/03.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3-14, 16, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bretschneider et al (6,008,807).

With respect to independent claim 17, and dependent claims 3-5 and 10-11, Bretschneider discloses a "slide show presentation system"—refer to Bretschneider's

abstract. Bretschneider describes Microsoft Corporation's "PowerPoint" application.

Bretschneider further discloses:

"browser unit to obtain web page information using address information defined on an information network, and to output the obtained information" and "storage unit to store a predetermined correspondence relationship between a plurality of pieces of address information of web page information and a plurality of sequence numbers representing a predetermined output sequence" at abstract (*browser mode*), figure 1, column 3 (line 65) through column 4 (line 23), and column 6 (lines 44-58).

Bretschneider discloses the computer used to execute the slide presentation program (columns 3-4). Bretschneider discloses a *permanent storage medium 108* for storing the program and slide data. Refer also to Bretschneider's column 6 (lines 44-58), in which he discloses retrieving slide presentations from the Internet (hence, "web page information . . . defined on an information network").

"control unit to increment a control variable indicating one of the sequence numbers . . . ". Refer to Bretschneider's figures 9A-9C and column 10 (bottom) through column 13. (Note: there is a typographical error at the bottom of column 10—"6A-6C" should read "9A-9C".) Specifically, refer to Bretschneider's column 11 (lines 28-33), in which he discloses *allow a slide presentation author to select slides that are to be included in the slide show*. Bretschneider allows the user to customize the slide show to include selected slides.

It is noted that Bretschneider fails to explicitly teach the "user-specified correspondence relationship between . . . address information and . . . sequence

numbers". However, such a teaching would have been obvious to one of ordinary skill in the art at the time of the invention in view of Bretschneider's teaching of the custom presentation (figure 9A (922), column 11) because the user can choose which slides and in what sequence. Thus, there is an implied correspondence between the address of the slide and the "sequence number". In other words, the order of presentation of the slides implies the claimed "sequence numbers".

With respect to dependent claims 6-7, refer to Bretschneider's column 11 (lines 33-41). Bretschneider teaches optionally using preset timings to automatically advance slides in the slide show. As per claim 7, it is noted that Bretschneider does not explicitly teach "changes the time intervals according to each of the plurality of sequence numbers". Bretschneider does teach "*Using timings*". It is noted that this term is plural, i.e., timings—not timing. Thus, it appears that Bretschneider teaches separate time intervals for individual slides. However, even if this were not the case, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide variable time intervals because it was well known at the time of the invention that some slides could be skimmed over quickly, while others would warrant more time.

With respect to dependent claims 8-9, refer to Bretschneider's column 11 (lines 11-27), in which he discloses narrations. It is noted that Bretschneider fails to teach "music". However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include "music" because "narrations" broadly reads on any audio

annotation, including music or other sound effects. Since Bretschneider allows for narrations, then a sound card is implied, which indicates that other forms of audio annotation would be possible (and desirable, depending on what the user would want to include in the presentation).

With respect to dependent claim 16, Bretschneider's disclosure of automatic advancement via predetermined time intervals provides a teaching of "does not require manual advancement"—column 11, lines 33 et seq.

With respect to independent claims 12-14, refer to the rationale relied upon in rejecting independent claim 17. Claims 12 and 13 are essentially directed to "computer-readable storage medium which stores a program for causing a computer to perform" steps corresponding to the functions set forth in claim 17. Claim 14 is a "slide show method" for preparing and presenting a slide show that essentially corresponds with the functions set forth in claim 17.

Response to Arguments

4. Applicant's arguments filed 10/6/03 have been carefully considered, but are non-persuasive.

On page 6 of the amendment, Applicant asserts the following point:

In regard to the feature of canceled claim 11 that was amended into the independent claims, Bretschneider is limited to the web page information being stored on a remote computer (Bretschneider, col.10, lines 2-7). Disadvantageously, Bretschneider requires a connection to a network or ISP. In

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contrast, one of the advantages of the present invention is that Internet access is not required during presentation of the slide show because the web page information is downloaded and stored as a local file (Specification, p.10, lines 6-9).

Specifically, independent claims 12-14 of the subject application (as amended herein) recite "storing the web page information to be outputted corresponding to address information wherein the web page information which is stored is obtained using address information." Independent claim 17 of the subject application (as amended herein) recite "a storage unit to store the web page information to be outputted corresponding to address information, wherein the browser unit obtains the web page information which is stored in the storage unit using access information informed by the control unit."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the advantages of the present invention is that Internet access is not required during presentation of the slide show....") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


What is in fact claimed is "storing the web page information to be outputted corresponding to address information wherein the web page information which is stored is obtained using address information." And, this feature is shown by Bretschneider even though Bretschneider may require a connection to the Internet. Note that the web page information is downloaded from the remote site and then stored in the local computer before presented to the user. Since any web page presented on a computer is first stored in memory of the computer, the storage of the web page and the access of the web page using the address information are clearly shown.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Stephen Hong
Primary Examiner
Art Unit 2178
November 14, 2003